



APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

RECEIVED

SEP. 17 2001

Technology Center 2100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of Dale Burns

Serial No.: 09/182,033 Group Art Unit: 2164

Filed: 10/29/98 Examiner: Kazimi, H.

For: ELECTRONIC COUPON PROCESSING SYSTEM

Box AF
Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 1.192,

Appellant submits the following:

I. REAL PARTY IN INTEREST

Based on information supplied by Appellant, and to the best of Appellant's legal representatives' knowledge, the real party in interest is the inventor, Dale Burns.

II. RELATED APPEALS AND INTERFERENCES

Appellant, as well as Appellant's assigns and legal representatives are unaware of any appeals or interferences which will be directly affected by, or which will directly affect, or

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

RECEIVED

SEP 17 2001

Technology Center 2100

have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 30-49 are currently pending. No claims have been allowed. Claims 1-29 have been canceled. Claims 30-49 are appealed. Claims 30-49, as finally rejected, are set forth in the attached Appendix.

IV. STATUS OF AMENDMENTS

An amendment to claim 41 is submitted herewith to correct a grammatical error.

The present amendment is proper in that it places the application in better form for appeal by materially reducing or simplifying the issues for appeal. The present amendment does not add any new matter, but merely corrects a verb tense.

Therefore, Appellant respectfully submits that the proposed amendment does not raise any new issues and should be entered.

V. SUMMARY OF THE INVENTION

Appellants' disclosed and claimed invention is directed to an electronic coupon processing system.

The claimed electronic coupon processing system is used for eliminating a presentation of printed coupons at a checkout register and includes: a plurality of consumer identification

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

means wherein each consumer identification means is associated with a consumer (page 7, line 17 to page 8, line 1; 210 in figure 2, 310 in figure 3); a plurality of consumer accounts associated with said plurality of consumer identification means (page 6, lines 18-20, page 7, lines 2-7; coupon database 100 in figures 1-3); a database for storing information for each of said plurality of consumer accounts (coupon database 100); at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession into said associated consumer account based on input of the consumer's consumer identification means so as to eliminate any need to present printed coupons at a checkout register (page 7, lines 10-14 and lines 17-18, page 10, line 21 to page 11, line 2; 120 of figure 1 and associated text);

at least one checkout register capable of collecting a consumer's purchase information, said register additionally being connected to said database (page 4, lines 18-21, page 9, lines 1-7; all of figure 2); means associated with said checkout register for reconciling the unutilized coupon information in each consumer's consumer account with the consumer's purchase information based solely on input of said consumer's consumer identification means (page 4, lines 18-21, page 9, lines 1-7; all

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

of figure 2); and means for updating said consumer's consumer account to reflect utilization of coupons (page 4, line 21, page 9, lines 10-11, page 11, lines 3-4 and 15-16, page 18, lines 7-9; figures 2 and 3), wherein said at least one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account (page 6, lines 6-8, page 7, lines 10-14 and lines 17-18, page 10, line 21 to page 11, line 2; 100 of figures 1 and 3).

Modifications include embodiments wherein: a consumer's frequent shopper card comprises said consumer identification means (page 7, lines 19-21); additional unutilized coupon information is added to a consumer account by the system based on market information collected for a consumer associated with said consumer account (page 8, lines 17-20); said database is connected to registers at a particular store or group of stores (page 8, lines 4-6, page 12, lines 20-21; figures 2 and 3); said at least one means for each of said plurality of consumers to enter unutilized coupon information from printed coupons in their possession consists of a scanner (page 7, lines 4 and 12, original claims 7, 13, 19, and 22); said scanner is located in a store and said store further includes means for viewing and a

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

printer for providing a printout of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means (page 8, lines 7-13); said printout includes an aisle location for products associated with said coupon information in said consumer account (page 8, line 12); said means for reconciling automatically sends both purchase information and coupon information directly to a clearinghouse or a manufacturer for reimbursement (page 9, line 15 to page 10, line 1, page 12, line 3; figure 3); means for providing Internet review of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means (page 8, lines 14-17); means to provide a printout of unutilized coupon information in a consumer's consumer account (page 8, lines 7-13).

The process of the present invention is electronic coupon process for eliminating a presentation of printed coupons at a checkout register and includes: associating a plurality of consumers with a plurality of consumer identification means (page 7, line 17 to page 8, line 1; 210 in figure 2, 310 in figure 3); associating a plurality of consumer accounts with said plurality of consumer identification means (page 6, lines 18-20, page 7, lines 2-7; coupon database 100 in figures 1-3); storing

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

information for each of said plurality of consumer accounts in a database (coupon database 100); entering, at a location separate from a checkout register, unutilized coupon information from printed coupons in a consumer's possession into said associated consumer account based on input of said consumer's consumer identification means to eliminate any need to present printed coupons at a checkout register (page 7, lines 10-14 and lines 17-18, page 10, line 21 to page 11, line 2; 120 of figure 1 and associated text); collecting said consumer's purchase information at a checkout register that is connected to said database (page 4, lines 18-21, page 9, lines 1-7; all of figure 2); reconciling the unutilized coupon information in said consumer's consumer account with the purchase information based solely on input of said consumer identification means of said specific consumer (page 4, lines 18-21, page 9, lines 1-7; all of figure 2); and updating a consumer account of said consumer to reflect utilization of coupons (page 4, line 21, page 9, lines 10-11, page 11, lines 3-4 and 15-16, page 18, lines 7-9; figures 2 and 3), wherein consumers are limited to adding unutilized coupon information into their consumer account solely from printed coupons in their possession (page 6, lines 6-8, page 7, lines 10-14 and lines 17-18, page 10, line 21 to page 11, line 2; 100 of

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

figures 1 and 3).

Additional embodiments include: those wherein a consumer's frequent shopper card is used as said consumer identification means (page 7, lines 19-21); adding additional unutilized coupon information to a consumer account based on market information collected for a consumer associated with said consumer account (page 8, lines 17-20); connecting said database to registers at a particular store or group of stores (page 8, lines 4-6, page 12, lines 20-21; figures 2 and 3); entering unutilized coupon information from printed coupons using a scanner (page 7, lines 4 and 12, original claims 7, 13, 19, and 22); locating said scanner in a store and said store further providing means for viewing and a printer for providing a printout of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means (page 8, lines 7-13); printing out an aisle location for products associated with said coupon information in said consumer account (page 8, line 12); wherein reconciling automatically sends both purchase information and coupon information directly to a clearinghouse or a manufacturer for reimbursement (page 9, line 15 to page 10, line 1, page 12, line 3; figure 3); Internet review of unutilized coupon information in a consumer's consumer account based on

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

input of said consumer's consumer identification means (page 8, lines 14-17); a printout of unutilized coupon information in a consumer's consumer account (page 8, lines 7-13).

VI. ISSUES

The issues on Appeal are:

Do the drawings comply with 37 CFR §1.83(a)?

Does the specification comply with the written description requirement of the first paragraph of 35 USC §112?

Do claims 30-49 comply with the written description requirement of the first paragraph of 35 USC §112?

Do claims 30-49 comply with the definiteness requirement of the second paragraph of 35 USC §112?

Are claims 30-49 obvious over U.S. Patent No. 4,882,675 to Nichtberger et al. in view of U.S. Patent No. 5,822,735 to DeLapa et al.?

VII. GROUPING OF CLAIMS

Appealed claims 30-35, 37, 39-45, 47 and 49 stand or fall together.

Appealed claims 36 and 46 stand or fall together based on the reliance of "Official Notice" in the grounds of rejection.

Appealed claims 38 and 48 stand or fall together based on

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

the reliance of "Official Notice" in the grounds of rejection.

VIII. ARGUMENTS

Drawings

Appellant submits that the drawing figures comply with 37 CFR §1.183(a) with respect to the claim language "*means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account*" because the "Consumer Brings Coupons" box 110 of figure 1 and the "Consumer With Coupons" box 110 of figure 3 are the inputs leading to the only arrows entering the Coupon Database 100.

If Appellant illustrates only one path from the consumer with coupons to the database, as in figures 1 and 3, it is unclear how else an "only means" could be illustrated.

Specification - 35 USC §112 Written Description

Appellant submits that the specification provides adequate written description to support "*wherein...means for each consumer to enter unutilized coupon information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account*" in claims 30-39 and "*wherein consumers are limited to adding unutilized coupon*

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

information into their consumer account solely from printed coupons in their possession" in claims 40-49. The written description providing support for this aspect of the present invention is found primarily in the explicit definition of coupons found on page 6:

"The term coupons, as used herein, shall mean any mode of communication with a consumer or a potential consumer offering a specific discount to the consumer *wherein the consumer needs to bring such proof back to a store for redemption.*" Emphasis added.

By defining the term coupon in such a manner, other means of entering coupon information into the database are thereby eliminated, since a coupon, by definition, must be capable of being brought with the consumer.

Claim Rejections - 35 USC §112 Written Description

Appellant submits that the subject matter of claims 30-49 has been described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention for the reasons cited in the preceding paragraph.

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

Claim Rejections - 35 USC §112 Definiteness

Appellant submits that the terms "the consumer's consumer identification means" and "said consumer's consumer identification means" have sufficient antecedent basis in the claims since both claims have antecedent basis in the form of "a consumer", "a plurality of consumers", or "each consumer" (see lines 4 and 8 of claim 30 and lines 3 and 8 of claim 40), claim 30 provides for "a plurality of consumer identification means wherein *each consumer identification means is associated with a consumer*" and claim 40 provides "associating a plurality of consumers with a plurality of consumer identification means" such that each of the/said consumers has "the (or said) consumer's consumer identification means."

Claim Rejections - 35 USC §103

Claims 30-49 were rejected as being obvious in view of Nichtberger et al. in view of De Lapa et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met (See M.P.E.P. Section 2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Second, there must be a reasonable expectation of success. This requirement is primarily concerned with less predictable arts, such as the chemical arts.

Finally, the prior art must teach or suggest each and every limitation of the claimed invention, as the invention must be considered as a whole. *In re Hirao*, 535 F.2d 67, 190 U.S.P.Q. 15 (C.C.P.A. 1976).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present case, at least the first and third of these criteria have not been met in the Final Office Action.

No Motivation to Combine

First, there is no suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the electronic coupon system of Nichtberger et al. with the paper coupon system of De Lapa et

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

al. in order to include that the one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided to consumers to add unutilized coupon information to their consumer account.

As per MPEP 2141.02, a prior art reference must be considered as a whole, *including portions that would lead away from the invention. W. L. Gore and Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed Cir. 1983). In the present case, Nichtberger et al. cannot be used to render the present claims obvious under 35 USC §103 because, as a whole, it teaches away from the present invention.

Although col. 29, lines 56-68 suggest the addition of a paper coupon scanner to the system of Nichtberger et al., the primary purpose of the Nichtberger et al. patent is to *distribute and redeem coupons electronically with a paperless system*. To accomplish this, customers make an electronic selection of coupons from a display. Therefore, to *eliminate the electronic selection of coupons by customers as a distribution means*, as would be necessary to make such an obviousness rejection, would *destroy the primary purpose of the Nichtberger et al. patent and make it unsatisfactory for electronic coupon distribution*. As

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

such, the rejection is improper for failing to consider the reference as a whole. It is also improper in accordance with M.P.E.P. 2143.01 as lacking a suggestion or motivation to modify the reference *in the manner suggested by the rejection* since to do so would render Nichtberger et al. unsatisfactory for its intended purpose of electronic coupon distribution.

The secondary reference, De Lapa et al., fails to teach or suggest anything that would correct this deficiency in Nichtberger et al.

De Lapa et al. was relied on in the rejection for teaching "that the one means for each consumer to enter unutilized coupon information from printed coupons is the only means for consumers to add unutilized coupon information into their consumer account." However, the cited portion of De Lapa et al., as well as the rest of the reference, fails to disclose or teach that consumers can add unutilized coupon information to their accounts.

De Lapa et al. discloses a focused coupon system wherein a database with demographic-type information is used to generate a set of coupons for a particular consumer, the coupons are printed and sent to the consumer, and, upon consumer use of the coupons, encoded redemption information is collected and used to generate

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

the next set of coupons for the consumer. Consumers in the system of De Lapa et al. have no means whatsoever for adding unutilized coupon information to their file in the database; all coupon generation is done by the system.

The end result of the system of De Lapa et al. is *paper coupons for redemption at a point-of-sale*, which is exactly the result that the primary purpose of Nichtberger et al. seeks to eliminate. Since De Lapa et al. fails to teach or suggest limiting consumer addition of unutilized coupons to their accounts to scanning of paper coupons, and the teaching of *producing paper coupons* in De Lapa et al. directly contradicts the primary purpose of *eliminating paper coupons* in Nichtberger et al., Appellant respectfully submits that there is no suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the electronic coupon system of Nichtberger et al. with the focused paper coupon system of De Lapa et al. in order to include that the one means for each consumer to enter unutilized coupon information from printed coupons is the only means provided to consumers to add unutilized coupon information to their consumer account.

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

All Claim Limitations Not Shown

None of the cited references disclose that the means for each consumer to enter unutilized coupon information from printed coupons is the only means provided to consumers to add unutilized coupon information to their consumer account, as presently required by the claims.

In view of the above arguments, Appellant respectfully submits that claims 30-49 are novel and non-obvious over Nichtberger et al. in view of De Lapa et al.

Further in view of Official Notice

Further, claims 36 and 46 were rejected as being obvious over Nichtberger et al. in view of De Lapa et al., and further in view of Official Notice that "printing an aisle location on a coupon is old and well known in the art." Firstly, Appellant traverses this statement and requests a reference showing this teaching. Secondly, claims 36 and 46 are not drawn to "printing an aisle location on a coupon," but rather to providing a *printout of the aisle locations for products associated with a consumer's unutilized coupon information*. As such, the Official Notice fails to teach or fairly suggest the claimed limitation.

Likewise, claims 38 and 48 were rejected as being obvious

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

over Nichtberger et al. in view of De Lapa et al., and further in view of Official Notice that "reviewing coupons through the Internet is old and well known in the art." Again, Appellant traverses this statement and requests a reference showing this teaching. Also, claims 38 and 48 are not merely drawn to "reviewing coupons through the Internet," but rather to providing Internet review of unutilized coupon information *in a consumer's consumer account based on input of said consumer's consumer identification means*. As such, the Official Notice again fails to teach or fairly suggest the claimed limitation.

Accordingly, Appellant respectfully submits that claims 20-49 are novel and non-obvious over Nichtberger et al. in view of De Lapa et al..

IX. CONCLUSION

For the above reasons, Appellant respectfully submits that the Application conforms to the requirements of 35 U.S.C. §112 and that the Final Office Action of May 9, 2001 has failed to make out a *prima facie* case of obviousness with regard to claims 30-49, and therefore asks that the inadequate written description rejection, the indefiniteness rejection, and the obviousness rejection be reversed.

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

The present Brief on Appeal is being filed in triplicate.

Appellant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 18-1579.

Respectfully submitted,



Christopher B. Kilner
Registration No. 45,381
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive
Suite 1000
Reston, VA 20191
(703) 391-2900



PELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

CLAIM APPENDIX

30. An electronic coupon processing system for eliminating a presentation of printed coupons at a checkout register, comprising:
 - a plurality of consumer identification means wherein each consumer identification means is associated with a consumer;
 - a plurality of consumer accounts associated with said plurality of consumer identification means;
 - a database for storing information for each of said plurality of consumer accounts;
 - at least one means separate from a checkout register for each consumer to enter unutilized coupon information from printed coupons in the consumer's possession into said associated consumer account based on input of the consumer's consumer identification means so as to eliminate any need to present printed coupons at a checkout register;
 - at least one checkout register capable of collecting a consumer's purchase information, said register additionally being connected to said database;
 - means associated with said checkout register for reconciling the unutilized coupon information in each consumer's consumer account with the consumer's purchase information based solely on input of said consumer's consumer identification means; and
 - means for updating said consumer's consumer account to reflect utilization of coupons, wherein said at least one means for each consumer to enter unutilized coupon

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

information from printed coupons is the only means provided for consumers to add unutilized coupon information into their consumer account.

31. The electronic coupon processing system of claim 30, wherein a consumer's frequent shopper card comprises said consumer identification means.
32. The electronic coupon processing system of claim 30, wherein additional unutilized coupon information is added to a consumer account by the system based on market information collected for a consumer associated with said consumer account.
33. The electronic coupon processing system of claim 30, wherein said database is connected to registers at a particular store or group of stores.
34. The electronic coupon processing system of claim 30, wherein said at least one means for each of said plurality of consumers to enter unutilized coupon information from printed coupons in their possession consists of a scanner.
35. The electronic coupon processing system of claim 34, wherein said scanner is located in a store and said store further includes means for viewing and a printer for providing a printout of

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means.

36. The electronic coupon processing system of claim 35, wherein said printout includes an aisle location for products associated with said coupon information in said consumer account.

37. The electronic coupon processing system of claim 30, wherein said means for reconciling automatically sends both purchase information and coupon information directly to a clearinghouse or a manufacturer for reimbursement.

38. The electronic coupon processing system of claim 30, further comprising means for providing Internet review of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means.

39. The electronic coupon processing system of claim 38, further comprising means to provide a printout of unutilized coupon information in a consumer's consumer account.

40. An electronic coupon process for eliminating a presentation of printed coupons at a checkout register, comprising:

associating a plurality of consumers with a plurality of consumer identification means;

associating a plurality of consumer accounts with said plurality of consumer identification means;

means;

storing information for each of said plurality of consumer accounts in a database;

entering, at a location separate from a checkout register, unutilized coupon information from printed coupons in a consumer's possession into said associated consumer account based on input of said consumer's consumer identification means to eliminate any need to present printed coupons at a checkout register;

collecting said consumer's purchase information at a checkout register that is connected to said database;

reconciling the unutilized coupon information in said consumer's consumer account with the purchase information based solely on input of said consumer identification means of said specific consumer; and

updating a consumer account of said consumer to reflect utilization of coupons,

wherein consumers are limited to adding unutilized coupon information into their consumer account solely from printed coupons in their possession.

41. The electronic coupon process of claim 40, wherein a consumer's frequent shopper card is used as said consumer identification means.

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

42. The electronic coupon process of claim 40, further comprising adding additional unutilized coupon information to a consumer account based on market information collected for a consumer associated with said consumer account.
43. The electronic coupon process of claim 40, further comprising connecting said database to registers at a particular store or group of stores.
44. The electronic coupon process of claim 40, further comprising entering unutilized coupon information from printed coupons using a scanner.
45. The electronic coupon process of claim 44, further comprising locating said scanner in a store and said store further providing means for viewing and a printer for providing a printout of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means.
46. The electronic coupon process of claim 45, further comprising printing out an aisle location for products associated with said coupon information in said consumer account.

APPELLANT'S BRIEF ON APPEAL
U.S. Application No. 09/182,033

47. The electronic coupon process of claim 40, wherein reconciling automatically sends both purchase information and coupon information directly to a clearinghouse or a manufacturer for reimbursement.
48. The electronic coupon process of claim 40, further comprising providing Internet review of unutilized coupon information in a consumer's consumer account based on input of said consumer's consumer identification means.
49. The electronic coupon process of claim 48, further comprising providing a printout of unutilized coupon information in a consumer's consumer account.

CERTIFICATE OF EXPRESS MAILING

Express Mail Mailing Label Number EL 891857937 US

Date of Deposit: September 10, 2001

I hereby certify that the Notice of Appeal; Amendment under 37 CFR 1.116, Brief on Appeal, and Check for \$310 (the \$155.00 notice of appeal fee the \$155.00 appeal brief fee) for the patent application of Dale Burns for a **ELECTRONIC COUPON PROCESSING SYSTEM**, Serial No. 09/182,033, are being deposited with the United States Postal Service for "Express Mail" service under 37 C.F.R. § 1.10 on the date indicated above and are addressed to Box AF, Commissioner for Patents, Washington, D.C. 20231.



Christopher B. Kilner
Registration No. 45,381
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive
Suite 1000
Reston, VA 20191